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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of **D'Achard van Enschut** Atty. Docket No.: **PHN 16-219 A**
Serial No.: **09/022,132** Group Art Unit: **3714**
Filed: **2/11/1998** Examiner: **White, C.**
Title: **METHOD FOR OPERATING A VIDEO GAME WITH BACKFEEDING A VIDEO IMAGE OF A PLAYER, AND A VIDEO GAME ARRANGED FOR PRACTISING THE METHOD**

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Enclosed is an original plus two copies of a revised Appeal Brief in the above-identified application, as required in the Office communication of 14 April 2004.

Respectfully submitted,

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**CERTIFICATE OF MAILING**
**It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**

**On 30 April 2004 By** _____.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of **D'Achard van Enschut** Atty. Docket No.: **PHN 16-219 A**
Serial No.: **09/022,132** Group Art Unit: **3714**
Filed: **2/11/1998** Examiner: **White, C.**
Title: **METHOD FOR OPERATING A VIDEO GAME WITH BACKFEEDING A VIDEO IMAGE OF A PLAYER, AND A VIDEO GAME ARRANGED FOR PRACTISING THE METHOD**

## APPELLANT'S REVISED BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This is an appeal from the decision of the Examiner dated 20 August 2003, finally rejecting claims 1-4 and 6-14 of the subject application, revised as required in the Office communication of 14 April 2004.

## I. REAL PARTY IN INTEREST

The above-identified application is assigned, in its entirety, to U.S. Philips Corporation, a company organized under the laws of the State of Delaware.

## II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have any bearing on the Board's decision in the pending appeal.

## III. STATUS OF CLAIMS

Claims 1-4 and 6-14 are pending in the application. Claims 1-4 and 6-14 stand rejected by the Examiner under 35 U.S.C. 112, first paragraph, and claims 1-4 and 6-9 stand rejected by the Examiner under 35 U.S.C. 103(a).

## IV. STATUS OF AMENDMENTS

An amendment was concurrently filed with the Appeal Brief of 27 December 2003, to remove the article "the" from a term lacking proper antecedent basis in each of claims 1, 6, and 10. The amendment and the Appeal Brief were not admitted, because of a misplacement of the Notice of Appeal at the USPTO. Receipt of the Notice of Appeal has been acknowledged in the Office communication of 14 April 2004. The Office communication of 14 April 2004 implicitly affirms the admittance of the Appeal Brief, but is silent with regard to the status of the amendment filed with the Appeal Brief. The attached claim listing includes the correction submitted on 27 December 2003.

## V. SUMMARY OF THE INVENTION

The invention comprises a video game system and method wherein one or more images of high-scoring players are back-fed into the gaming environment, and displayed on the displays of current players to increase the competitive nature of the game. The images may be a video clip, photograph, or other lifelike image. (Applicant's page 2, lines 4-13).

As illustrated in the example display of FIG. 2 of the Applicant's application, an image of the currently high-scoring player is displayed in field 72, and an image of the currently highest-ranking player of prior games is displayed in field 74. (Applicant's page 4, lines 10-15.)

Preferably, during the play of a game, images of players are collected and transferred to a central processing device (24 in FIG. 1). The central processing device 24 provides a ranking of the players' scores, and maintains a rank-ordering of both the high-ranking player of prior games as well as the high-scoring player in the current game. The central processing device 24 provides the image of the high-scoring player and the image(s) of one or more high-ranking players for display on the current players' displays, for example, at fields 72 and 74 of the example display of FIG. 2. (Applicant's page 3, line 1 through page 4, line 4).

By prominently displaying select images based on a ranking amongst current players, and/or a ranking amongst prior player, the competitive spirit and interest in playing the game is expected to increase, as each current player strives to have his/her

image displayed as one of the high-scorers. In particular, the prominent display of the high-scoring player in the current game provides for a dynamic representation of a closely matched game, for example, as the more prominent image continually changes when different players take the lead.

## VI. ISSUES

Are claims 10-14 patentable under 35 U.S.C. 112, first paragraph?

Are claims 1-4 and 6-9 patentable under 35 U.S.C. 112, first paragraph?

Are claims 1-4 and 6-8 patentable under 35 U.S.C. 103(a) over Sitrick (USP 4,521,014) and Breslow et al. (USP 4,710,873, hereinafter Breslow)?

Is claim 9 patentable under 35 U.S.C. 103(a) over Sitrick, Breslow, and Hogan et al. (USP 5,657,246, hereinafter Hogan), and/or Weiss (USP 5,821,983)?

## VII. GROUPING OF CLAIMS

Claims 1-4 and 6-9 stand or fall together; claims 10-14 stand or fall together.

## VIII. ARGUMENT

Claims 1-4 and 6-9 stand or fall together. Claims 10-14 stand or fall together, alone from claims 1-4 and 6-8 because independent claim 10 is patentably distinct from claims 1-4 and 6-8. Claims 1-4 and 6-9 stand rejected under 35 U.S.C. 112, first paragraph, and 35 U.S.C. 103(a), whereas claims 10-14 stand rejected only under 35 U.S.C. 112, first paragraph, thereby indicating that claims 10-14 contain material that is acknowledged to be patentable over the prior art, and thus are patentably distinct from claims 1-4 and 6-9.

The Office communication of 14 April 2004 suggests that the Appellant should explicitly designate the representative claim in each group that will be considered by the Board. The Appellant believes that such a designation by the Appellant is inconsistent with MPEP 1206, and respectfully declines.

The Office communication of 14 April 2004 also states that "Appellant may not argue multiple claims". The Appellant notes that MPEP 1206 requires that the appeal brief be responsive to every ground of rejection stated by the examiner. If the ground of

rejection encompasses multiple claims, the Appellant must present an argument that encompasses these multiple claims, either collectively or individually.

The Office communication of 14 April 2004 directs that the final rejection of claims 1-4 and 6-14 under 35 U.S.C. 112, first paragraph, be addressed as a separate issue for each grouping of claims. The rejection is correspondingly redundantly addressed below with regard to each group of claims, (10-14) and (1-4 and 6-9).

***Are claims 10-14 patentable under 35 U.S.C. 112, first paragraph?***

Independent claim 10, upon which claims 11-14 depend, includes the limitation that an image of the current high scoring player is displayed more prominently than the images of other players.

The Examiner asserts that: "One reasonably skilled in the art ***would not know how to make*** the image of the highest scoring player "***more prominent***" than the images of the other players" (Examiner's answer, continuation of item 5, lines 8-9, emphasis added). The Applicant respectfully traverses this assertion.

Webster defines "prominent" as: "standing out" or "readily noticeable" (Webster's New Collegiate Dictionary). The Applicant respectfully maintains that placing an image of a player in a fairly central field of a display, such as field 72 of the Applicant's example display of FIG. 2, causes that image to "stand out" and be "readily noticeable". The Applicant further maintains that one of ordinary skill in the art of programming would be able to control the placement of an image on a display, so as to cause it to appear in field 72 of the Applicant's example display of FIG. 2, or at any other location.

The Applicant respectfully notes that other techniques for presenting a "prominent" display of an image are common in the art, such as, flashing the image on-and-off, highlighting the image with a distinctive border, increasing the size of the image, adding video effects to the image, and so on. The decades of experience since video games were first introduced, as well as over a century of commercial advertising, provide ample teachings of how to make an image prominent in a display, and, correspondingly, how to make one image in a display more or less prominent than another image in the display. It is generally accepted and/or known in the art, for example, that a flashing image is more prominent than a non-flashing image; a centrally located image is more

prominent than an image in the periphery; a larger image is more prominent than a smaller image; a present image is more prominent than an absent image; and so on. In the Applicant's preferred embodiment, the image of the currently-leading player is prominently displayed in a stationary field 72 of the screen 60, directly above the image scene 62.

Because one of ordinary skill in the art at the time of the invention would have been able to create the Applicant's claimed invention without undue experimentation, including the display an image of a high-scoring player more prominently than images of other players, the Applicant respectfully maintains that claims 10-14 are patentable under 35 U.S.C. 112, first paragraph.

***Are claims 1-4 and 6-9 patentable under 35 U.S.C. 112, first paragraph?***

Each of the independent claims 1 and 6, upon which claims 2-4 and 7-8 depend, includes the limitation that an image of the current high scoring player is displayed more prominently than the images of other players.

The Examiner asserts that: "One reasonably skilled in the art ***would not know how to make*** the image of the highest scoring player "***more prominent***" than the images of the other players" (Examiner's answer, continuation of item 5, lines 8-9, emphasis added). The Applicant respectfully traverses this assertion.

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ample teachings of how to make an image prominent in a display, and, correspondingly, how to make one image in a display more or less prominent than another image in the display. It is generally accepted and/or known in the art, for example, that a flashing image is more prominent than a non-flashing image; a centrally located image is more prominent than an image in the periphery; a larger image is more prominent than a smaller image; a present image is more prominent than an absent image; and so on. In the Applicant's preferred embodiment, the image of the currently-leading player is prominently displayed in a stationary field 72 of the screen 60, directly above the image scene 62.

Because one of ordinary skill in the art at the time of the invention would have been able to create the Applicant's claimed invention without undue experimentation, including the display an image of a high-scoring player more prominently than images of other players, the Applicant respectfully maintains that claims 1-4 and 6-9 are patentable under 35 U.S.C. 112, first paragraph.

***Are claims 1-4 and 6-8 patentable under 35 U.S.C. 103(a) over Sitrick and Breslow?***

In claims 1 and 6 (and claim 10), upon which the other rejected claims depend, the Applicant claims a video game method and system wherein the image of a currently high-scoring player is more prominently displayed than images of other players.

MPEP 2142 specifically states that: "To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest ***all*** the claim limitations." (Emphasis added.)

In the final Office action, the Examiner does not assert that either Sitrick or Breslow, or their combination, teaches or suggests the limitation of displaying the currently high-scoring player more prominently than images of other players, as specifically claimed in each of the Applicant's independent claims. The final Office action relies upon the basis presented in the Office action of 22 May 2001 and the Examiner's Answer of 26 March 2002, both of which were issued before the above stated limitation was added to each independent claim. Neither of these papers addresses the

limitation of displaying the currently high-scoring player more prominently than images of other players, as specifically claimed in each of the Applicant's independent claims.

MPEP 2142 further states that: "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Because there is no evidence that either Sitrick or Breslow, individually or collectively, teach or suggest all of the limitations of the Applicant's claimed invention, the Applicant respectfully maintains that claims 1-4 and 6-8 are patentable under 35 U.S.C. 103(a) over Sitrick and Breslow.

***Is claim 9 patentable under 35 U.S.C. 103(a) over Sitrick, Breslow, and Hogan and/or Weiss?***

Claim 9 is dependent upon claim 6, discussed above.

In the final Office action, the Examiner does not assert that either Sitrick or Breslow or Hogan or Weiss, or their combination, teaches or suggests the limitation of displaying the currently high-scoring player more prominently than images of other players.

Because there is no evidence that either Sitrick or Breslow or Hogan or Weiss, individually or collectively, teach or suggest all of the limitations of the Applicant's claimed invention, the Applicant respectfully maintains that claim 9 is patentable under 35 U.S.C. 103(a) over Sitrick, Breslow, and Hogan or Weiss.

## CONCLUSIONS

Because one of ordinary skill in the art would be able to make the Applicant's invention, the Applicant respectfully requests that the Examiner's rejection of claims 10-14 under 35 U.S.C. 112, paragraph 1, be reversed by the Board, and the claims be allowed to pass to issue.

Because one of ordinary skill in the art would be able to make the Applicant's invention, the Applicant respectfully requests that the Examiner's rejection of claims 1-4 and 6-9 under 35 U.S.C. 112, paragraph 1, be reversed by the Board, and the claims be allowed to pass to issue.

Because neither Sitrick, nor Breslow, nor Hogan, nor Weiss, individually or collectively, teach or suggest displaying the image of a current high-scorer in a game more prominently than images of other players of the game, as specifically claimed in each of the Applicant's independent claims, the Applicant respectfully requests that the Examiner's rejection of claims 1-4 and 6-9 under 35 U.S.C. 103(a) be reversed by the Board, and the claims be allowed to pass to issue.

Respectfully submitted,

Robert M. McDermott, Attorney
Registration Number 41,508
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## APPENDIX

## CLAIMS ON APPEAL

1. A method for operating a multi-player video game, the method comprising:

enabling each player of multiple players to interact with a gaming environment,

machine-detecting a score and/or performance of each player in a particular session of the video game,

backfeeding into the gaming environment a video image of a currently high-scoring player, and

displaying the gaming environment, and the video image of the currently high-scoring player of the multiple players, wherein the image of the currently high scoring player is displayed in a more prominent location than images of others of the multiple players, during the particular session of the video game.

2. A method as claimed in Claim 1, furthermore comprising

ranking high-scoring players in respectively successive playing sessions, and

providing a representation of one or more of the high-ranking players for display in subsequent playing sessions, based on the ranking.

3. A method as claimed in Claim 1, for use in a multiple player environment, wherein the video image of select players of the multiple players is selectively cross-wise fed back to the multiple players.

4. A method as claimed in Claim 1, wherein the video image of select players of the multiple players is made part of a composite image with one or more selected items taken from memory.

6. A video game system being arranged for running a multi-player video gaming environment, comprising

a user interface that is configured to enable each player of multiple players to interact with the gaming environment,

a detector that is configured to detect a score and/or performance of each player during a particular session of the video game,

a backfeeding device that is configured to:

backfeed into the gaming environment a video image of a currently high-scoring player of the multiple players, and

a display that is configured to display the gaming environment, and the video image of the currently high-scoring player, wherein the image of the currently high scoring player is displayed in a more prominent position than images of others of the multiple players, during the particular session of the video game, and

one or more cameras that are configured to provide the video image of each player.

7. A system as claimed in Claim 6, furthermore comprising ranking means for relatively ranking players in respectively successive playing sessions, and control means fed by the ranking means for providing video images of the high-ranking players to subsequent playing sessions.

8. A system as claimed in Claim 6, arranged for implementing a multiple player gaming environment, and having cross-wise communication means for selectively cross-wise backfeeding the video image to multiple players.

9. A method as claimed in Claim 1, further allowing the player to suppress during the session a presentation of the actual score, performance and/or video image to the backfeeding.

10. A method for operating a multi-player video game where each player of multiple players interacts with a gaming environment, the method comprising the acts of:

determining a current performance level of each player during a particular session of the video game, and

displaying a video image of one of the multiple players that has the currently highest performance level of the multiple players together with the gaming environment during the particular session of the video game, wherein the image of the currently high scoring player is displayed in a more prominent location than images of others of the multiple players.

11. A method as claimed in Claim 10, comprising the acts of:

ranking high-scoring players in respectively successive playing sessions, and

providing a representation of one or more of the high-ranking players for display in subsequent playing sessions, based on the ranking.

12. A method as claimed in Claim 10, comprising the act of backfeeding a video image of select players of the multiple players cross-wise back to the multiple players.

13. A method as claimed in Claim 12, comprising the act of enabling a player to suppress during the particular session at least one of a presentation of an actual present score, performance and video image of the player to the backfeeding.

14. A method as claimed in Claim 10, comprising the act of displaying a video image of select players of the multiple players as a part of a composite image with one or more selected items taken from memory.